

REMARKS

Claims 1, 2, 4-8 and 11-18 are pending and under consideration. Claim 1 has been amended to include the subject matter of former dependent claim 3. Support for the amendment to claim 1 may thus be found in claim 3 as originally filed. Since the amendment to claim 1 raises no new issue, and is believed to place the application in condition for allowance, entry is respectfully requested. In the alternative, entry of this amendment is requested as placing the application in better condition for appeal by, at least, reducing the number of issues outstanding. Further reconsideration is requested based on the foregoing amendment and the following remarks.

Response to Arguments:

The Applicants appreciate the consideration given to their arguments. The Applicants, however, are disappointed that their arguments were not found to be persuasive. Further reconsideration is thus requested.

Claim Rejections - 35 U.S.C. § 102:

Claims 7 and 15 were rejected under 35 U.S.C. § 102(b) as anticipated by US Patent No. 5,929,849 to Kikinis (hereinafter "Kikinis"). The rejection is traversed.

Claim 7 recites:

Sync information for synchronizing the program information with the relevant information from said broadcasting unit.

Kikinis neither teaches, discloses, nor suggests "sync information for synchronizing the program information with the relevant information from said broadcasting unit," as recited in claim 7.

The final Office Action asserts at page 3, lines 1-4 that tags are sync information. This is submitted to be incorrect. Tags, rather, are described as merely *linking* the URLs to the image entities. Nothing is said about *synchronizing* the relevant information, i.e. the resource on the Internet associated with the URL, with the program information, i.e. the image entities, at all. In particular, as described in Kikinis at column 9, lines 29-32:

At step 83 a data stream is received bearing entity data and one or more dynamic URLs in a data region separate from image frame data. The one or more URLs are linked to the image entities by a tag. The URLs can be sent before (ahead of) the images and stored in a cache.

Thus, even if the tags were considered to be synchronized to image entities, the URL's, i.e. the relevant information, are not. The URL's rather, are so unsynchronized they can be sent *ahead* of the broadcast and stored in a cache.

Furthermore, synchronizing is a temporal concept, i.e. it implies timing. Tags, or the Universal Resource Locators (URL) to which they link, on the other hand, are *spatial* concepts, which imply a location of the resource on the Internet associated with the URL. The tags in Kikinis, in particular, are linked to a URL, which indicates a location, not a timing, of resource. The time at which the user will view the resource located by the URL and, indeed, whether the user will follow the link represented by the URL at *all*, is entirely at the users' *discretion*. There is nothing synchronous about viewing the resource, nor is there any temporal relationship between the tagged image entities of Kikinis and the resources located by the URLs to which they are linked in Kikinis at all.

Even if, as asserted by the final Office Action, tags were considered to be synchronized to the frames, Kikinis is still not "synchronizing the program information with the relevant information from said broadcasting unit," as recited in claim 7, since the tags only point to a *location* of a resource on the Internet associated with the URL. In particular, as described in the Abstract of Kikinis:

The association data associates one or more image entities in successive frames with one or more URLs, and a viewer, by selecting an associated image entity in the display, causes the system to access the Internet, to connect to a source on the Internet associated with the URL, to download a WEB page from the source, and to display the WEB page in the display.

Since, in Kikinis, a viewer, by selecting an associated image entity in the display, causes the system to access the Internet and connect to a source on the Internet associated with the URL, Kikinis is not "synchronizing the program information with the relevant information from said broadcasting unit," as recited in claim 7. All the tag does in Kikinis is indicate to a user where there might be an advertisement for them to view, if they like, not *when* it will be viewed, or even *if* it will ever be viewed at all.

In Kikinis, rather, any connection to the data source associated to the image entity by the URL is in response to the *user* input, as described at column 4, lines 35-46:

In still a further aspect of the invention a method is provided for accessing additional information related to an image entity in a video display, comprising steps of (a) associating the image entity with a dynamic Universal Resource Locator (URL) transmitted between frames in a data stream including image frames for the video display; (b) selecting the entity in the video display by user input; (c) accessing the Internet via a Network Interface Module (NIM) in

response to the user input, and connecting to the data source associated with the URL; (d) downloading a WEB page from the data source; and (e) displaying the WEB page in the video display.

Since, in Kikinis, connection to the data source associated to the image entity by the URL is in response to the user input, Kikinis is not “synchronizing the program information with the relevant information from said broadcasting unit,” as recited in claim 7.

Claim 7 recites further:

Said sync information including the information about the time at which the object is displayed or the frames that contain the object, and the information about the display position at which the object is displayed.

Kikinis neither teaches, discloses, nor suggests “sync information including the information about the time at which the object is displayed or the frames that contain the object, and the information about the display position at which the object is displayed,” as recited in claim 7. As discussed above, the timing at which the advertisement will be displayed, or even whether it will be displayed at all, is up to the user in Kikinis. Thus, even if the tags of Kikinis were considered to be synchronized to the image entities, there is still no “information about the time at which the object is displayed,” as recited in claim 7.

Finally, claim 7 recites:

Synchronously outputting the program information and relevant information in accordance with the stored sync information.

Kikinis neither teaches, discloses, nor suggests “synchronously outputting the program information and relevant information in accordance with the stored sync information,” as recited in claim 7. As discussed above, even if the tags of Kikinis were considered to be synchronized to the image entities, there is still no “synchronously outputting the program information and relevant information in accordance with the stored sync information,” as recited in claim 7. Claim 7 is submitted to be allowable. Withdrawal of the rejection of claim 7 is earnestly solicited.

Rejection of Claim 15:

Claim 15 recites:

Sync information for synchronizing the program information with the relevant information from said broadcasting unit, said sync information including the information about the time at which the object is displayed or the frames that contain the object, and the information about the display position at which the object is displayed.

Kikinis neither teaches, discloses, nor suggests “sync information for synchronizing the program information with the relevant information from said broadcasting unit, said sync information includes the information about the time at which the object is displayed or the frames that contain the object, and the information about the display position at which the object is displayed,” as discussed above with respect to the rejection of claim 7. Claim 15 is submitted to be allowable, for at least those reasons discussed above with respect to the rejection of claim 7. Withdrawal of the rejection of claim 15 is earnestly solicited.

Claim Rejections - 35 U.S.C. § 103:

Claims 1, 2, 4, 5, 6, and 11-14 were rejected under 35 U.S.C. § 103 as being unpatentable over Kikinis in view of US Patent No. 6,131,086 to Walker et al., (hereinafter “Walker”). The rejection is traversed. Reconsideration is earnestly solicited.

Claim 1 recites:

Extracting an object appearing in a program which is to be broadcast so as to generate an object extraction table in accordance with the information of the time or frame and display position of the object on a screen.

Kikinis neither teaches, discloses, nor suggests “extracting an object appearing in a program which is to be broadcast so as to generate an object extraction table in accordance with the information of the time or frame and display position of the object on a screen,” as recited in claim 1. The final Office Action acknowledged this deficiency of Kikinis at page 4, lines 5 and 6, and proposes to use product database 263 of Walker to make up for this deficiency of Kikinis, saying at page 4, line 7 that the benefits are “notoriously well known.”

Product database 263 of Walker, which is shown in Fig. 6, however, is not an object extraction table at all, and thus cannot make up for the deficiencies of Kikinis with respect to the claimed invention. Product database 263 of Walker, rather, is a table of information on products indexed by a program record number 610 so an operator terminal 140 can identify the particular product that the viewer is interested in purchasing. In particular, as described at column 5, lines 10-34 of Walker:

Product database 263 provides a table of information on products indexed by a program record number 610, which may be the same as program record number 510. By accessing the information in product database 263, operator terminal 140 can identify the particular product that the viewer is interested in purchasing. As shown in FIG. 6, database 263 preferably includes the following fields on each product offered for sale: program record number 610; prop type 615; program identifying data 620; prop identifying data 625; product description 630; vendor 635; product cost 640; availability 645; and time code 650. Program and product

identifying fields 620 and 625 include information that enables the identification of programs, and products offered for sale on the programs, respectively. Such information describes characteristics of the entertainment programs and associated products. Thus, program identifying data field 620 typically contains information similar to episode plot field 550. Time code field 650 includes a range of time code values corresponding to the time during which the respective product was displayed on the program. Product database 263 further includes information about the type of product for sale (prop type 615), and retail information about the product description 630, vendor 635, product cost 640, and availability 645. In practice, product database 263 may include fewer or more fields for product information.

Since product database 263 of Walker is a table of information on products indexed by a program record number 610 so an operator terminal 140 can identify the particular product that the viewer is interested in purchasing, Walker is not "extracting an object appearing in a program which is to be broadcast so as to generate an object extraction table in accordance with the information of the time or frame and display position of the object on a screen," as recited in claim 1.

Furthermore, the reference to "the benefits of generating and referencing a table are notoriously well known e.g. quick obtaining information," at lines 6, 7, and 8 at page 4 of the final Office Action appears to be a taking of Official Notice. The Applicant respectfully traverses the Official Notice and demands authority for the statement. The Applicant specifically points out the following errors in the final Office Action.

First, the final Office Action uses common knowledge as the principal evidence for the rejection. As explained in M.P.E.P. § 2144.03(E):

Any facts so noticed should . . . serve only to 'fill in the gaps' in an insubstantial manner which might exist in the evidentiary showing made by the Examiner to support a particular ground of rejection. It is never appropriate to rely solely on common knowledge in the art without evidentiary support in the record as the principal evidence upon which a rejection was based.

Second, the noticed fact is not considered to be common knowledge or well-known in the art. In this case, the limitation is not of notorious character or capable of instant and unquestionable demonstration as being well-known. Instead, this limitation is unique to the present invention. See M.P.E.P. § 2144.03(A) ("the notice of facts beyond the record which may be taken by the Examiner must be "capable of such instant and unquestionable demonstration as to defy dispute").

Third, there is no evidence supporting the assertion. See M.P.E.P. § 2144.03(B) ("there must be some form of evidence in the record to support an assertion of common knowledge").

Fourth, it appears that the rejection is based, at least in part, on personal knowledge. 37 C.F.R. § 1.104(d)(2) requires such an assertion to be supported with an affidavit when called for by the Applicant. Thus, Applicant calls for support for the assertion with an affidavit.

Furthermore, the above-mentioned section of Kikinis dealing with sending URLs ahead of the broadcast teaches against the use of an object extraction table, since that would only be needed if the URL were to be associated with an image entity. It is submitted, therefore, that persons of ordinary skill in the art who read the references for all they contain would not have been motivated to modify Kikinis, as proposed in the final Office Action, since an object extraction table would only be needed if the URL were to be associated with an image entity, which is not the case.

Claim 1 recites further:

Generating sync information to be used for synchronizing the program information with the relevant information.

Kikinis neither teaches, discloses, nor suggests “generating sync information to be used for synchronizing the program information with the relevant information,” as discussed above with respect to the rejection of claim 7. Walker does not either, and thus cannot make up for the deficiencies of Kikinis with respect to the claimed invention.

Finally, claim 1 recites:

Wherein the relevant information is the advertisement information about advertisement of the object.

Kikinis neither teaches, discloses, nor suggests “the relevant information is the advertisement information about advertisement of the object,” as recited in claim 1. In Kikinis, rather, the advertisement is *in* the broadcast, and the URL is linked *to* the advertisement. This is exactly opposite to “the relevant information is the advertisement information about advertisement of the object,” as recited in claim 1. Walker does not either, and thus cannot make up for the deficiencies of Kikinis with respect to the claimed invention. Claim 1 is submitted to be allowable. Withdrawal of the rejection of claim 1 is earnestly solicited.

Claims 2, 4, and 5 depend from claim 1 and adds further distinguishing elements. Claims 2, 4, and 5 are thus also submitted to be allowable. Withdrawal of the rejection of claims 2, 4, and 5 is also earnestly solicited.

Rejection of Claim 6:

Claim 6 recites:

Extracting an object appearing in a program which is to be broadcast to generate an object extraction table in accordance with the information of the time or frame and display position of the object on a screen.

Neither Kikinis nor Walker teach, disclose, or suggest “extracting an object appearing in a program which is to be broadcast to generate an object extraction table in accordance with the information of the time or frame and display position of the object on a screen,” as discussed above with respect to the rejection of claim 1.

Furthermore, persons of ordinary skill in the art who read the references for all they contain would not have been motivated to modify Kikinis as proposed in the final Office Action, as also discussed above with respect to the rejection of claim 1.

Claim 6 recites further:

Generating the sponsor-recruiting information for recruiting a sponsor who pays for the cost of displaying the extracted object.

Neither Kikinis nor Walker teach, disclose, or suggest “generating the sponsor-recruiting information for recruiting a sponsor who pays for the cost of displaying the extracted object,” as recited in claim 6. The fact that a sports organization may also present season ticket prices and the like, and even accomplish sales of Internet links, has nothing to do with recruiting a sponsor directly to the owner at the receiver side. Claim 6 is submitted to be allowable for at least those reasons discussed above with respect to the rejection of claim 1. Withdrawal of the rejection of claim 6 is earnestly solicited.

Rejection of Claim 11:

Claim 11 recites:

Extracting an object appearing in a program which is to be broadcast to generate an object extraction table in accordance with the information of the time or frame and display position of the object on a screen.

Neither Kikinis nor Walker teach, disclose, or suggest “extracting an object appearing in a program which is to be broadcast to generate an object extraction table in accordance with the information of the time or frame and display position of the object on a screen,” as discussed above with respect to the rejection of claim 1.

Furthermore, persons of ordinary skill in the art who read the references for all they contain would not have been motivated to modify Kikinis as proposed in the final Office Action, as also discussed above with respect to the rejection of claim 1. Claim 11 is submitted to be

allowable for at least those reasons discussed above with respect to the rejection of claim 1.
Withdrawal of the rejection of claim 11 is earnestly solicited.

Rejection of Claim 12:

Claim 12 recites:

Extracting an object appearing in a program which is to be broadcast to generate an object extraction table in accordance with the information of the time or frame and display position of the object on a screen.

Neither Kikinis nor Walker teach, disclose, or suggest “extracting an object appearing in a program which is to be broadcast so as to generate an object extraction table in accordance with the information of the time or frame and display position of the object on a screen,” as discussed above with respect to the rejection of claim 1.

Furthermore, persons of ordinary skill in the art who read the references for all they contain would not have been motivated to modify Kikinis as proposed in the final Office Action, as also discussed above with respect to the rejection of claim 1.

Claim 12 recites further:

Generating the sponsor-recruiting information for recruiting a sponsor who pays for the cost of displaying the extracted object.

Neither Kikinis nor Walker teach, disclose, or suggest “generating the sponsor-recruiting information for recruiting a sponsor who pays for the cost of displaying the extracted object,” as discussed above with respect to the rejection of claim 6. Claim 12 is submitted to be allowable for at least those reasons discussed above with respect to the rejections of claims 1 and 6.
Withdrawal of the rejection of claim 12 is earnestly solicited.

Rejection of Claim 13:

Claim 13 recites:

An object extraction unit which extracts an object appearing in a program which is to be broadcast so as to generate an object extraction table in accordance with the information of the time or frame and display position of the object on a screen.

Neither Kikinis nor Walker teach, disclose, or suggest “an object extraction unit which extracts an object appearing in a program which is to be broadcast so as to generate an object extraction table in accordance with the information of the time or frame and display position of the object on a screen,” as discussed above with respect to the rejection of claim 1.

Claim 13 recites further:

A sync-information generation unit which generates the sync information for synchronizing the program information with the relevant information.

Neither Kikinis nor Walker teach, disclose, or suggest “a sync-information generation unit which generates the sync information for synchronizing the program information with the relevant information,” as discussed above with respect to the rejection of claim 1. Claim 13 is submitted to be allowable for at least those reasons discussed above with respect to the rejection of claim 1. Withdrawal of the rejection of claim 13 is earnestly solicited.

Rejection of Claim 14:

Claim 14 recites:

An object extraction unit which extracts an object appearing in a program which is to be broadcast so as to generate an object extraction table in accordance with the information of the time or frame and display position of the object on a screen.

Neither Kikinis nor Walker teach, disclose, or suggest “an object extraction unit which extracts an object appearing in a program which is to be broadcast so as to generate an object extraction table in accordance with the information of the time or frame and display position of the object on a screen,” as discussed above with respect to the rejection of claim 1.

Furthermore, persons of ordinary skill in the art who read the references for all they contain would not have been motivated to modify Kikinis as proposed in the final Office Action, as also discussed above with respect to the rejection of claim 1.

Claim 14 recites further:

A sponsor-designating-information receiver which receives the sponsor-designating information for designating that the owner of the receiving unit becomes the sponsor who pays for the cost of displaying the object to said receiving unit.

Neither Kikinis nor Walker teach, disclose, or suggest “a sponsor-designating-information receiver which receives the sponsor-designating information for designating that the owner of the receiving unit becomes the sponsor who pays for the cost of displaying the object to said receiving unit,” as discussed above with respect to the rejection of claim 6. Claim 14 is submitted to be allowable for at least those reasons discussed above with respect to the rejections of claims 1 and 6. Withdrawal of the rejection of claim 14 is earnestly solicited.

Rejection of Claim 17:

Claim 17 recites:

Generating sync information to be used for synchronizing the program information with the relevant information.

Neither Kikinis nor Walker teach, disclose, or suggest “generating sync information to be used for synchronizing the program information with the relevant information,” as discussed above with respect to the rejection of claim 1. Claim 17 is submitted to be allowable for at least those reasons discussed above with respect to the rejection of claim 1. Withdrawal of the rejection of claim 17 is earnestly solicited.

Rejection of Claim 18:

Claim 18 recites:

generating sponsor-recruiting information for recruiting a sponsor for the extracted object.

Neither Kikinis nor Walker teach, disclose, or suggest “generating sponsor-recruiting information for recruiting a sponsor for the extracted object,” as discussed above with respect to the rejection of claim 6. Claim 18 is submitted to be allowable for at least those reasons discussed above with respect to the rejection of claim 6. Withdrawal of the rejection of claim 18 is earnestly solicited.

Rejection of Claims 8 and 16:

Claims 8 and 16 were rejected under 35 U.S.C. § 103 as being unpatentable over Kikinis. The rejection is traversed.

Claim 8 recites, in pertinent part:

Transmitting sponsor-designating information to the broadcasting unit for designating that the owner of the receiving unit becomes the sponsor who pays for the cost of displaying the object to said broadcasting unit.

Kikinis fails to disclose transmitting sponsor-designating information for designating that the sponsor becomes a sponsor for the object to said broadcasting unit, as acknowledged graciously in the final Office Action at page 7. The final Office Action seeks to compensate for this deficiency of Kikinis by taking Office Notice that transmitting a purchase confirmation to a user is well known in the art. The Applicant respectfully traverses the Official Notice and demands authority for the statement, as discussed above.

Furthermore, a rejection under 35 U.S.C. § 103(a), as explained in the M.P.E.P. §706.02(j)(D), requires more than an assertion that an element was known at the time the invention was made. In particular, under the provisions of M.P.E.P. §706.02(j)(D):

35 U.S.C. 103 authorizes a rejection where, to meet the claim, it is necessary to modify a single reference or to combine it with one or more other references. After indicating that the rejection is under 35 U.S.C. 103, the examiner should set forth in the Office action: . . .

(D) an explanation why one of ordinary skill in the art at the time the invention was made would have been motivated to make the proposed modification. M.P.E.P. § 706.02(j)(D).

"It is insufficient that the prior art [discloses] the components . . . either separately or used in other combinations; there must be some teaching, suggestion, or incentive to make the combination made by the inventor." Northern Telecom, Inc. v. Datapoint Corp., 908 F.2d 931, 15 USPQ2d 1321 (Fed. Cir. 1990), *cert. denied*, 498 U.S. 920 (1990).

"When a rejection depends on a combination of prior art references, there must be some teaching, suggestion, or motivation to combine the references." In re Rouffet, 47 USPQ2d 1453, 1456 (Fed. Cir. 1998); see also M.P.E.P. § 2143.01. Virtually all inventions are combinations of old elements. See In re Rouffet, 47 USPQ2d at 1457.

If identification of each claimed element in the prior art were sufficient to negate patentability, the final Office Action could use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. See *Id.* To prevent the use of hindsight based on the teachings of the patent application, the final Office Action must show a motivation to combine the references in the manner suggested. See *Id.* at 1457-1458.

Many things may have been well known *individually* at the time of the invention. A rejection under 35 U.S.C. § 103(a) requires a showing that the *combination* of elements was obvious, *i.e.*, a showing that persons of ordinary skill in the art at the time the invention was made would have seen fit to form the claimed *combination*. Here, the final Office Action has pointed to no teaching, either in the cited references or the general state of the art, as to why one of ordinary skill in the art at the time the invention was made would have been motivated to modify Kikinis to form the claimed combination, beyond an assertion that transmitting a purchase confirmation to a user is well known in the art. Claim 8 is submitted to be allowable. Withdrawal of the rejection of claim 8 is earnestly solicited.

Rejection of Claim 16:

Claim 16 recites, in pertinent part:

A sponsor-designating-information transmission unit which transmits the sponsor-designating information for designating that the owner of the receiving unit becomes a sponsor for paying the cost of displaying the object to said broadcasting unit.

Kikinis fails to disclose transmitting sponsor-designating information for designating that the sponsor becomes a sponsor for the object to said broadcasting unit, as acknowledged graciously in the final Office Action at page 7. The Applicant respectfully traverses the Official Notice and demands authority for the statement. Here, the final Office Action has pointed to no teaching, either in the cited references or the general state of the art, as to why one of ordinary skill in the art at the time the invention was made would have been motivated to modify Kikinis to form the claimed combination, beyond an assertion that transmitting a purchase confirmation to a user is well known in the art, as discussed above with respect to the rejection of claim 8. Claim 16 is submitted to be allowable as well, for at least those reasons discussed above with respect to the rejection of claim 8. Withdrawal of the rejection of claim 16 is earnestly solicited.

Conclusion:

Accordingly, in view of the reasons given above, it is submitted that all of claims 1-8 and 11-18 are allowable over the cited references. Allowance of all claims 1-8 and 11-18 and of this entire application is therefore respectfully requested.

If there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

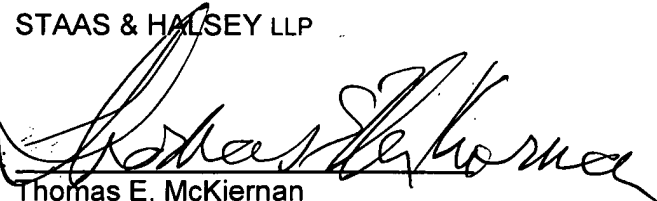
Respectfully submitted,

STAAS & HALSEY LLP

Date:

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By


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